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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,589	06/10/2005	Tillmann Freudenberg	8470G-00022/NP	1428

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EXAMINER

NGUYEN, XUAN LAN T

ART UNIT PAPER NUMBER

3683

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/506,589

Applicant(s)

FREUDENBERG ET AL.

Examiner

Lan Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The Search Report listed on form PTO-1449 has been lined out since such Report is not considered as a proper prior art document; and would not be printed on the face of the patent should the instant application matures into a patent. The Report has been considered during the examination of the application. The Examiner appreciates the submission of the Report.
2. The Foreign Patent Documents cited on the IDS submitted by Applicant dated 9/2/04 have been crossed out because the documents are missing from the file.

Drawings

3. The drawings are objected to because:
 - Reference 30 points to the wrong part.
 - The figures are not being illustrated consistently with each other.
 - Figure 1 lacks element 19.
 - Figures 2a, 2b lack element 52b.
 - Element 52a is being illustrated differently in figures 2a, 2b compared to element 52a of figure 1.
 - Figures 2a, 2b also lack element 18.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 6 and 7 claim a dominant shaft and a second shaft. The specification

does not explain what these shafts are, how they relate to the instant invention, where they are being located, etc. Claims 6 and 7 are not further treated for the above stated reason.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 10, as presented, is depending from claim 7. However, it is believed that Applicant has intended for claim 10 to depend from claim 8 based on the content of claim 10. Claim 10 is being treated as being depending from claim 8.
- Claims 17-20 are confusing and are contradictory. Claim 17 claims a membrane with a limited free play. However, the free play is released in idling mode. It is unclear what the "released" condition would be? It is suggested that claims 17-20 be amended to recite the structure of the claimed subject matter instead of the conditions of the subject matter; since "free play" is a condition of the membrane. To further prosecution, claims 17-20 are being treated as claiming a membrane, a lowering plate, a shift rod and an actuating device to lower the lowering plate via the shift rod.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Franz et al. (USP 4,836,515).

Re: claims 1-3, Franz et al. shows an assembly bearing with hydraulic damping, for supporting engines and/or gear-boxes in motor vehicles, as in the present invention, comprising: a working chamber 15 and a compensation chamber 16, said working chamber and said compensation chamber having partially elastically deformable walls 12, 18 and being separated from one another by a dividing wall 17, a damping channel 3 through which a liquid is guided, said damping channel interconnecting said working chamber and said compensation chamber, and an additional passage opening, central opening of wall 17, that can be variably adjusted from outside of the assembly, as shown, wherein the dividing wall comprises a decoupling device, membrane 26, for isolating high-frequency, low-amplitude vibrations and the additional passage opening is disposed upstream of the decoupling device, as shown.

Re: claims 4 and 5, Franz shows the control system in column 1, lines 55-62, for adjusting the passage opening.

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Re: claim 16, Franz shows in column 2, lines 15-41, that the bearing assembly is capable of dampening out the different vibrations and modes generated from the vehicle.

Re: claims 17-20, Franz further shows the a membrane 26, a lowering plate 22, a shift rod 24 and an actuating device 25 to lower the lowering plate via the shift rod.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franz et al. (USP 4,836,515) in view of Noguchi et al. (USP 4,877,225).

Re: claim 8, Franz's assembly bearing as rejected in claim 1, lacks a conical surface. Noguchi et al. teach in figure 1 a lowering plate 36A,B corresponding to a conical surface 32A of the passage opening in dividing wall 30 of the bearing assembly 10 in order to provide a range of sizes for the passage opening to further increase the dampening capability of the assembly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Franz's assembly to include a lower plate corresponding to a conical surface of a passage opening as taught by Noguchi in order to provide a range of sizes for the passage opening to further increase the dampening capability of the assembly.

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Re: claim 9, as modified, an outer edge 36B of the lowering plate would be bent away from the decoupling device.

Re: claim 10, as modified, the peripherally extending conical surface 32A would be provided on a ring disposed on the dividing wall 17.

Re: claim 11, as modified, the lowering plate 36A,B would be formed of a shifting rod 24 disposed essentially centrally in the bearing and is axially movable, said rod being guided through the corresponding central openings from below, through the decoupling device, through the compensation chamber, and extending entirely into the working chamber, as shown in figure 1 of Franz.

Re: claims 12 and 13, Franz shows motor 25 for an axially displacing the shifting rod 24.

Re: claim 14, Franz shows that the electric motor is operable by means of a control system in column 1, lines 53-55.

Re: claim 15, as modified, the lowering plate 36A,B would be provided with an opening 42 for reducing the damping.

Double Patenting

12. Claim 1 of this application conflict with claim 1 of Application No. 10/506,369. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the

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conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is (571) 272-7121. The examiner can normally be reached on Monday through Friday, 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on (571) 272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**XUAN LAN NGUYEN
PRIMARY EXAMINER**

Lan Nguyen 11/30/06